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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,351	11/12/2003	Michael D. Schmal	MQPP-0043	6764

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

m/k.v

Office Action Summary**Application No.**

10/706,351

Applicant(s)

SCHMAL ET AL.

Examiner

Patricia L. Nordmeyer

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8, 11-18, 20-24, 27-30, 32-38, 40 and 67-72 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 11-18, 20-24, 27-30, 32-38, 40 and 67-72 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on February 13, 2004 was has been considered being considered by the examiner. However, the Examiner believes there is a mistake with the last US Patent listed on the PTO-1449. The patent number and inventor information did not match. The inventorship has been changed to reflect the cited document, but the Examiner that the patent number is the incorrect number.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 11 recites the limitation "blended monolayer thermoplastic elastomer film" in 11. There is insufficient antecedent basis for this limitation in the claim. The preamble of the claim is referring to a multi-layer film instead of a monolayer film.

Correction/clarification is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*,

Art Unit: 1772

422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1 – 4, 6 – 8, 11 – 18, 20 – 24, 27 – 30, 32 – 38, 40 and 67 – 72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 43 of U.S. Patent No. 6,682,792 to Schmal et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of U.S. Patent 6,682,792 are broad enough to encompass or include the invention, which is recited in the present patent application.

Schmal et al. discloses a high temperature food preparation film comprising a blended monolayer thermoplastic elastomer film having about 40 weight percent of thermoplastic elastomer block copolymers and about 60 weight percent of non-elastic polyesters, where said high temperature cooking applications occur at from about 212 degrees Fahrenheit to about 400 degrees Fahrenheit (Column 25, lines 26 – 34). The blended monolayer thermoplastic elastomer film has a tensile yield strength of at least 2900 pounds per square inch (Column 25, lines 44 – 47), an oxygen barrier coefficient of less than about 100 cc-mil/100in²/day (Column 25, lines 42 – 43) and a water vapor barrier having a transmission coefficient of less than about 20gms/100in²/day (Column 25, lines 39 – 41). The thermoplastic elastomer block copolymers are selected from a group consisting of polyester-ester block copolymers, polyether-ester block copolymers

or combinations thereof (Column 25, lines 53 – 57), and the non-elastic polyester is a reaction product of a carboxylic acid and a diol (Column 25, lines 58 – 60), where the non-elastic polyester is polybutylene terephthalate (Column 25, lines 61 – 63). A multi-layer thermoplastic elastomer film for a high temperature food preparation film comprising a first layer comprising thermoplastic elastomer block copolymers having about 40 weight percent of thermoplastic elastomer block copolymers and a second layer having about 60 weight percent of non-elastic polyesters, where said high temperature cooking applications occur at from about 212 degrees Fahrenheit to about 400 degrees Fahrenheit with the elastomer film not substantially adhering to food during high temperature food preparation (Column 26, lines 3 – 22). The multi-layer thermoplastic elastomer film has a tensile yield strength of at least 4000 pounds per square inch (Column 26, lines 23 – 26), an oxygen barrier coefficient of less than about 100 cc-mil/100in²/day (Column 26, lines 20 – 22) and a water vapor barrier having a transmission coefficient of less than about 20gms/100in²/day (Column 26, lines 18 – 22). The thermoplastic elastomer block copolymers are selected from a group consisting of polyester-ester block copolymers, polyether-ester block copolymers or combinations thereof (Column 26, lines 27 – 31), and the non-elastic polyester is a reaction product of a carboxylic acid and a diol (Column 26, lines 32 – 34), where the non-elastic polyester is polybutylene terephthalate (Column 25, lines 35 – 37). The first layer comprises an interior film layer having a thickness from about 0.001 to about 0.01 inches, and the second layer comprises an exterior film layer having a thickness from about 0.001 to about 0.01 inches (Column 26, lines 42 – 48). One addition layer comprising thermoplastic elastomer block copolymers, non-elastic polyesters or combinations thereof

is added in one embodiment of the film (Column 26, lines 49 – 52). The multi-layered film is made by co-extruding the first and second layers, extruding the first and second layers separately, disposing the second layer on the first layer and forming the multi-layered film by rolling the first layer and second layer between a heated roller or by disposing the first layer and the second layer between an interleaving adhesive layer (Column 26, lines 53 – 63). A high temperature food preparation bag comprising a sealed end, at least one side wall extending away from said sealed end, each of said at least one side wall having a distal edge, an open end defined by distal edge, said bag formed from a blended thermoplastic elastomer film having about 40 percent of thermoplastic elastomer block copolymers and a second layer having about 60 weight percent of non-elastic polyesters, where said high temperature cooking applications occur at from about 212 degrees Fahrenheit to about 400 degrees Fahrenheit with the elastomer film not substantially adhering to food during high temperature food preparation (Column 26, line 64 to Column 27, line 19). The thermoplastic elastomer bag has a tensile yield strength of at least 2900 pounds per square inch (Column 27, lines 28 – 31), an oxygen barrier coefficient of less than about 100 cc-mil/100in²/day (Column 27, lines 23 – 24) and a water vapor barrier having a transmission coefficient of less than about 20gms/100in²/day (Column 27, lines 20 – 22). In one embodiment, a multi-layer thermoplastic film bag is constructed from the multi-layered film (Column 27, lines 31 – 37), where the first layer comprises an interior film layer having a thickness from about 0.001 to about 0.01 inches, and the second layer comprises an exterior film layer having a thickness from about 0.001 to about 0.01 inches (Column 27, lines 42 – 48). One additional layer comprising thermoplastic elastomer block copolymers, non-elastic

polyesters or combinations thereof is added in one embodiment of the film (Column 27, lines 49 – 52). The thermoplastic elastomer block copolymers are selected from a group consisting of polyester-ester block copolymers, polyether-ester block copolymers or combinations thereof (Column 27, lines 54 – 58), where the non-elastic polyester is polybutylene terephthalate (Column 25, lines 62 – 64).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2 and 6 – 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al. (USPN 3,907,926).

Brown et al. disclose a blended thermoplastic monolayer film (Column 1, lines 7 – 8) made with 5 to 200 parts of polybutylene terephthalate, a non-elastic polyesters, per 100 parts of copolyetherester (Column 1, lines 35 – 41), giving weight percents between 10 to 90 percent. The film has a yield strength between 28, 500 – 68,000 psi (Column 9, Table II, Tensile Modulus). To make the polyester, a reaction between the a carboxylic acid and a diol (Column 2, lines 44 – 51).

With regards to the high temperature cooking applications occurring at about 212 °F to about 400 °F, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

8. Claims 1, 3 and 6 – 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Suokas et al. (USPN 6,146,764).

Suokas et al. disclose a blended thermoplastic monolayer film made with 60 to 94 parts of isotropic polymer and 5 to 40 parts of a liquid crystal polymer (Column 2, lines 55 – 59), where the liquid crystal polymer is poly(ester ether) (Column 4, lines 11 – 14) and the isotropic polymer is polybutylene terephthalate (Column 6, lines 43 – 55). To make the polyester, a reaction between the a carboxylic acid and a diol (Column 4, lines 23 – 29). The film has an oxygen permeability of less than 100 cc-mil per 100 hundred square inches per day (Column 12, lines 40 – 41).

With regards to the high temperature cooking applications occurring at about 212 °F to about 400 °F, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (USPN 3,907,926).

Brown et al. disclose a blended thermoplastic monolayer film (Column 1, lines 7 – 8) made with 5 to 200 parts of polybutylene terephthalate, a non-elastic polyester, per 100 parts of copolyetherester (Column 1, lines 35 – 41), giving weight percents between 10 to 90 percent. The film has a yield strength between 28, 500 – 68,000 psi (Column 9, Table II, Tensile Modulus). To make the polyester, a reaction between a carboxylic acid and a diol (Column 2, lines 44 – 51) takes place. One of ordinary skill in the art would have recognized the claimed film would have a water vapor transmission coefficient of less than 20gms/100 in²/day and the blended monolayer film is not damaged due to adherence of said film to said food product during said high temperature food preparation since Brown et al. teach that the film contains the same parameters as the claimed invention. Therefore, one of ordinary skill in the art would readily determine the optimum water vapor transmission coefficient depending on the desired end results and absence of unexpected results.

Art Unit: 1772

11. Claims 11 – 18, 20 – 23 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. (USPN 4,264,667).

Murakami et al. disclose a multi layer thermoplastic film (Column 8, lines 60 – 63) made with an exterior layer of polybutylene terephthalate (Column 8, line 61) mixed other materials to have a film containing 10 to 90% by weight (Column 9, lines 1 – 7), a non-elastic polyester, and an interior layer containing at least 10 to 90% by weight of polyether ester (Column 2, lines 33 – 39, Column 3, line 32 and Column 9, lines 1 – 7). The film has a yield strength between 15 to 30 kg/mm² (Column 8, line 51). To make the polyester, a reaction between a carboxylic acid and a diol (Column 3, lines 34 – 36) takes place. The film has a total thickness of 1 to 1000 μ (Column 8, lines 47 – 49). One of ordinary skill in the art would have recognized the claimed film would have a water vapor transmission coefficient of less than 20gms/100 in²/day, an oxygen barrier having a permeability coefficient of less than 100 cc-mil per hundred square inches per day and film is not damaged due to adherence of said film to said food product during said high temperature food preparation since Murakami et al. teach that the film contains the same parameters as the claimed invention. Therefore, one of ordinary skill in the art would readily determine the optimum water vapor transmission coefficient and oxygen barrier permeability coefficient depending on the desired end results and absence of unexpected results.

Murakami et al. discloses the polyester film being laminated to other material except for an additional film layer comprising thermoplastic elastomer block copolymers,

Art Unit: 1772

non-elastic polyesters or a combination thereof. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add another layer of the material, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

The limitation of the fabrication of the multi layer film through extrusion and adhesive layers in claim 23 is a process limitation. The determination of patentability for a product claim with a process limitation is based on the product itself and not on the method of production. In this case, the limitation of attaching the layers of film through either adhesive or extrusion is a method of production and therefore does not determine the patentability of the product itself. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113.

12. Claims 5, 24, 27 – 29, 38, 40 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (USPN 3,907,926) in view of Simhaee (USPN 6,135,281).

Brown et al. disclose a blended thermoplastic monolayer film (Column 1, lines 7 – 8) made with 5 to 200 parts of polybutylene terephthalate, a non-elastic polyester, per 100 parts of copolyetherester (Column 1, lines 35 – 41), giving weight percents between 10 to 90 percent. The film has a yield strength between 28, 500 – 68,000 psi (Column 9, Table II, Tensile Modulus). To make the polyester, a reaction between a carboxylic acid and a diol (Column 2, lines 44 – 51) takes place. One of ordinary skill in the art would

have recognized the claimed film would have a water vapor transmission coefficient of less than 20gms/100 in²/day and the blended monolayer film is not damaged due to adherence of said film to said food product during said high temperature food preparation since Brown et al. teach that the film contains the same parameters as the claimed invention. Therefore, one of ordinary skill in the art would readily determine the optimum water vapor transmission coefficient depending on the desired end results and absence of unexpected results. However, Brown et al. fail to disclose a bag with a sealed end, at least one side wall extending away from the sealed containing a distal end and the seal end comprising a star seal, heat seal or an ultrasonic seal.

Simhaee teaches a star seal (Column 3, lines 1 – 3 and lines 7 – 9) with a side wall extending away from the seal (Figure 1) in a bag (Column 3, lines 9 – 11) used to hold food (Column 1, lines 13 – 14) for the purpose of having bags that are stored in a continuous strip that are easy to open (Column 1, lines 49 – 53).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have formed the film of Brown et al. into a bag with a star seal that is used to hold food in order to have bags that are stored in a continuous strip that are easy to open as taught by Simhaee.

13. Claims 30 – 37, 67, 68 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. (USPN 4,264,667) in view of Simhaee (USPN 6,135,281).

Murakami et al. disclose a multi layer thermoplastic film (Column 8, lines 60 – 63) made with an exterior layer of polybutylene terephthalate (Column 8, line 61) mixed other materials to have a film containing 10 to 90% by weight (Column 9, lines 1 – 7), a non-elastic polyester, and an interior layer containing at least 10 to 90% by weight of polyether ester (Column 2, lines 33 – 39, Column 3, line 32 and Column 9, lines 1 – 7). The film has a yield strength between 15 to 30 kg/mm² (Column 8, line 51). To make the polyester, a reaction between a carboxylic acid and a diol (Column 3, lines 34 – 36) takes place. The film has a total thickness of 1 to 1000 μ (Column 8, lines 47 – 49). One of ordinary skill in the art would have recognized the claimed film would have a water vapor transmission coefficient of less than 20gms/100 in²/day, an oxygen barrier having a permeability coefficient of less than 100 cc-mil per hundred square inches per day and film is not damaged due to adherence of said film to said food product during said high temperature food preparation since Murakami et al. teach that the film contains the same parameters as the claimed invention. Therefore, one of ordinary skill in the art would readily determine the optimum water vapor transmission coefficient and oxygen barrier permeability coefficient depending on the desired end results and absence of unexpected results. However, Murakami et al. fail to disclose a bag with a sealed end, at least one side wall extending away from the sealed containing a distal end and the seal end comprising a star seal, heat seal or an ultrasonic seal.

Simhaee teaches a star seal (Column 3, lines 1 – 3 and lines 7 – 9) with a side wall extending away from the seal (Figure 1) in a bag (Column 3, lines 9 – 11) used to hold

Art Unit: 1772

food (Column 1, lines 13 – 14) for the purpose of having bags that are stored in a continuous strip that are easy to open (Column 1, lines 49 – 53).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have formed the film of Brown et al. into a bag with a star seal that is used to hold food in order to have bags that are stored in a continuous strip that are easy to open as taught by Simhace.

Murakami et al. discloses the polyester film being laminated to other material except for an additional film layer comprising thermoplastic elastomer block copolymers, non-elastic polyesters or a combination thereof. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add another layer of the material, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.


Art Unit: 1772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln
pln


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/10/04